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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,210	07/28/2003	Daniel G. Brady	27556	5311

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7590

06/01/2007

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/629,210

Applicant(s)

BRADY ET AL.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7, 8, 12-14, 33, 36, 37, 41, 42 and 45-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 12-14, 33, 36, 37, 41, 42 and 45-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 19, 2007 has been entered.

Claim Objections

Claims 47 and 49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In particular, claims 47 and 49 appear to merely repeat limitations of the base claim and claim 47 may even attempt to broaden the base claim language by leaving out the term "respectively."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 7, 8, 13, 41, 42, 45, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al (US 6,231,603) or, in the alternative, under 35

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U.S.C. 103(a) as obvious over Lang (US 6,231,603) alone. Lang anticipates the claim language where the primary lens as claimed is posterior lens (72) of Lang, and the supplemental lens as claimed is IOL lens (110); see Figure 5 and column 6, line 32 et seq. Note that the IOL lens can be diffractive and that this language is written as the alternative, thus clearly suggesting that an wholly refractive or diffractive lens can be utilized; see column 4, lines 24-34 and column 1, lines 50-62. Furthermore, since the IOL lens is monofocal or multifocal it necessarily must have an optical power of either positive or negative. Figure 3 shows that the IOL lens have both positive diopter (positive power) regions and negative diopter (negative power) regions.

Alternatively, one could argue that the present claim language is not met because the power of the posterior lens is not specified. However, the Examiner asserts that the lens system of Lang would inherently be designed to correct the vision of the patient so that it would not be excessive or insufficient. Moreover, it would have been at least *prima facie* obvious to design the posterior lens of Lang to compensate for the negative power regions or positive power regions of the IOL so that the images created by the lens system would not be distorted.

With regard to claim 8 specifically, there is no special definition for operatively coupled. Since the lenses of Lang operate with light, they are considered to be operatively coupled to the extent required by the present claim language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al (US 6,231,603) in view of Cohen (US 5,117,306). Lang et al (US 6,231,603) fails to describe the details of the diffractive lens embodiment, and thus, fails to disclose utilizing echelettes and the diffraction profile. However, Cohen teaches that it was known to make diffractive intraocular lenses that are positively or negatively powered, that include echelettes, and that have first or multi-ordered profiles as claimed; see the figures and claims 19 and 22 thereof. Therefore, it is the Examiner's position that it would have been obvious to provide a diffractive supplemental lens having the characteristics disclosed by Cohen for the same reasons Cohen uses the same and in order to make a wide variety of lenses suitable for many different patients.

Regarding claim 33, the echelettes of the formula on column 1, line 35 are on the order of a wavelength (unspecified wavelength) of light in size.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al (US 6,231,603) in view of Patel (US 5,366,502). Lang et al (US 6,231,603) fails to use a toric diffractive lens as claimed. However, Patel teaches that such lenses were known; see column 8, lines 1-10. Therefore, it is the Examiner's position that it would have been obvious to use a toric lens in the Lang invention for the same reasons that Patel uses the same and in order to aid a patient with an astigmatism (via a toric lens).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al (US 6,231,603) in view of Portney (US 6,197,058) or Nordan et al (US 2003/0097176). Lang fails to teach the thickness of the diffractive supplemental lens as claimed. However, Portney (see column 7, lines 59-62) and Nordan (see abstract) both teach that lens thicknesses of less than 250 microns were known. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to make the Lang supplemental lens less than 250 microns thick for the same reasons as the secondary references, and in order to make the lens insertable through a small incision.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al (US 6,231,603) in view of Copeland et al (US 2002/0042653). Lang fails to teach a blue blocker or tint feature as claimed. However, Copeland teaches that it was known to incorporate blue blocking or tint into intraocular lenses prior to the invention of the Applicants' invention; see the abstract. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to incorporate blue blocker or tint into the lens of Lang for the same reasons that Copeland does the same, that is, to achieve maximum visual acuity.

Claims 7 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al (US 6,231,603) in view of Bandhauer et al (US 2004/0230300) or Miller (WO 03/000154).

As an alternative to the vaulted feature as claimed in claim 7, one could interpret the claim language as being limited to some feature connecting the two lenses in this fashion. However, since Bandhauer or Miller both teach that such connection features

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were known, it is the Examiner's position that it would have been obvious to connect the lenses of Lang in this fashion for ease of insertion and to provide a definite separation distance.

As an alternative interpretation of "operatively coupled" of claim 8 that requires a physical coupling of the two lenses, the Examiner sets forth the following rejection. Lang can be interpreted as not meeting the claim language because it could be said to not teach operatively coupling of the lenses in that they are not shown physically coupled. However, both Bandhauer and Miller teach that it was known to physically couple similar lens systems together; see Figure 11 of Bandhauer and see Figure 6 of Miller. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to couple the lenses of Lang together at the extreme ends thereof for the same reasons that the secondary references do the same or to set the distance from each other prior to accommodation.

Claims 46 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (US 6,231,603) in view of Cohen (US 4,995,715). Lang fails to disclose the use of a blazed profile as claimed. However, Cohen ('715) teaches that it was known to utilize blazed profiles on diffractive lenses within the art; see column 6, lines 26-31. Therefore, it is the Examiner's position that it would have been obvious to utilize a blazed profile on the Lang diffractive lens for the same reasons that Cohen utilizes the same.

With regard to claims 50 and 51, Lang fails to disclose first order profiles and echelettes as presently required. However, Cohen ('715) teaches that it was known to

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the prior art at the time to make diffractive lenses of first order and with echelettes; see column 9, lines 30-33. Therefore, it is the Examiner's position that it would have been obvious to provide Lang with these features for the same reasons that the prior art to Cohen utilized the same or to provide a patient with the needed correction in a conventional device with well-documented features and properties.

Response to Arguments

In response to the traversal filed March 19, 2007 that Lang does not teach a positively powered or negatively powered supplemental lens, the Examiner asserts that the IOL lens must necessarily have a focal power, either positively or negatively, because it disclosed as having a monofocal or multifocal power. In other words, if the lens has a finite focal power, then it has either a positive or negative focal power. Moreover, Figure 3 of Lang clearly shows that the lens has positive and negative power or diopter regions. For these reasons, the claim language is considered fully met.

With regard to the traversal that the power is based upon the power of the other lens, the Examiner asserts that "limitation" is not really a positive limitation that requires a particular structure in the lenses because the actual power, negative or positive, is not actually fixed. Since it can be either power, it is the Examiner's position that the claim language is at least obvious over Lang alone.

With regard to the traversal that Lang does not teach a blazed profile, the Examiner asserts that it was known to utilize a blazed profile within the art of diffractive lenses. For this reason, it would have been obvious to utilize the same in the Lang diffractive lenses for the same reasons as the prior art.

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Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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